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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/072,574 | 02/06/2002 | Markus Kukuk | 2001P07456 US01 | 1940 |

7590 01/04/2005
Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|-------------------------------|-------------------------------|--|
| Office Action Summary | Application No. 10/072,574 | Applicant(s) KUKUK, MARKUS | |
| | Examiner John P. Leubecker | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-31 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18, 20-25, 29 and 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to nothing more than the manipulation of abstract concepts (parameterizing, determining, etc.) without any practical application of those concepts. Eligible subject matter under 35 USC 101 includes machines, compositions of matter, articles of manufacture and processes. However, not all processes have been held to be statutory processes. The manipulation of abstract ideas in the form of a process claim has been held to be one of the exceptions to statutory subject matter.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-11, 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Guthrie et al. (U.S. Pat. 6,409,686) for the reasons set forth in numbered paragraph 5 of the previous Office Action, paper number 06102004.

Art Unit: 3739

4. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Alft et al. (US 2003/0173113) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 06102004.

Allowable Subject Matter

5. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With regards to claim 19, it is this examiner's opinion that the steps of inserting the scope to a landmark, etc. are a practical application of the previously recited abstract concepts and is thus statutory.

Response to Arguments

6. Applicant's arguments filed September 17, 2004 have been fully considered but they are not persuasive.

Regarding the Guthrie et al. reference, the Examiner has interpreted the probe and digitizer arm as the "flexible instrument". Due to its physical existence and particular construction, the "flexible instrument" of Guthrie et al. inherently has physical parameters and physical parameter limitations. The probe of Guthrie inherently has a length. This is a parameter. Each segment of the digitizer arm inherently has a length. These are parameters. The amount of distance the probe can travel through the probe holder (2) is inherently known. This is a parameter. The amount of rotation that the probe exhibits within the probe holder is inherently known. This is a parameter. The amount of rotation of each segment of the digitizer arm with respect to each

Art Unit: 3739

other is known. This is a parameter. The list goes on. Each of these and many other parameters are inherently recognized by anyone making or using such device. As recognized by Applicant, the "parameterizing" the flexible instrument merely involves recognizing its physical characteristics and limits on movement. Therefore, the Examiner takes the position that Guthrie et al. teaches the claimed "parameterizing" step.

For the same reasons as discussed above, the Examiner takes the position that Alft et al. teach the "parameterizing" step. It also must be pointed out that the Alft et al. bore planning method would be totally useless if physical characteristics and movement limitations of the boring machine are not taken into consideration when planning the bore plan. Recognition of these physical characteristics and movement limitations meet the "parameterizing" step.

Although previously not readily apparent to the Examiner, due to recent training, it has been determined that a rejection under 35 USC 101 is appropriate for most of the claims. Accordingly, a rejection appears above.

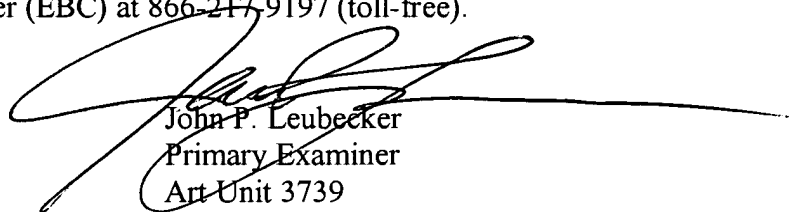
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl